

### **REMARKS**

This Amendment is responsive to the Final Office Action of June 11, 2003. Applicant respectfully submits that this Amendment should be entered because it, Applicant believes, places the pending claims in condition for immediate allowance or removes issues for appeal.

Applicant gratefully acknowledges the Examiner's notations, appearing on pages 2-3 of the Office Action, that "[t]he amendment (amendment C) submitted with Paper No. 15 and the request for reconsideration (Paper No. 18) were timely filed and are considered to be responsive" and that "[c]laims 112-140 of amendment C have been renumbered as 135-162, respectively."

Applicant however, would like to bring few minor clarifications to the Examiner's attention. Applicant believes that the claims 112-140, after the renumbering, should have been 135-163, not 135-162 as pointed out by the Examiner. Accordingly, the new claims presented herein have been numbered from 164 onwards. Further, Applicant respectfully submits that claims 158-163, not claims 157-161, have been intended by the Applicant as claims directed to manufacturing engineered tissue.

#### **I. Claims**

Claims 112 - 163 were pending.

Claims 112 - 163 stood rejected.

Claims 112-163 have been canceled without prejudice and new claims 164-250 have been presented. Support for these new claims can be found throughout the specification and the claims as filed. For example, support for the independent claim 164 can be found, for example, at page 3, line 14 through page 4, line 13 of the specification. No new matter is added by these new claims. Applicant respectfully submits that it reserves the right to present the canceled claims in one or more continuation applications.

#### **II. Double Patenting**

Prior claims 112-156 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application Nos. 09/338,908 (now issued as a patent 6,581,011 on June 17, 2003) and 09/338,909 (now issued as a patent 6,611,833 on August 26, 2003). This rejection is respectfully traversed.

First, Applicant disagrees with the Examiner's assertion that "all of the claims are directed to applying a plurality of imaging methods to a plurality of tissue specimens and to derive various structural and functional indices." Further, in view of the fact that the present claims are distinguishable from claims in the patents 6,581,011 and 6,611,833 and further in view of the fact that allowability of the present claims has not yet been acknowledged, Applicant believes that it is premature to file a Terminal Disclaimer at this time. Accordingly, withdrawal of this rejection is respectfully requested.

**III. Rejections Under 35 U.S.C. § 112 First Paragraph, Written Description**

Prior claims 112-163 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In particular, the Examiner averred that "[n]o basis is seen for the claims as presently written." Without conceding the validity of this rejection, and solely for purposes of expediting prosecution of this Application, Applicant has elected to present the invention in different terms as set forth in the new claims 164-250. Accordingly, Applicant respectfully submits that this rejection is moot. Reconsideration is respectfully requested.

**IV. Rejections Under 35 U.S.C. § 112, First Paragraph, Enablement:**

Prior claims 157-162 stand rejected under 35 U.S.C. § 112, first paragraph. The Examiner asserts that these claims are not enabled. Specifically, the Examiner asserts that the specification provides guidance for profiling tissue specimens and does not provide sufficient guidance to make the engineered tissue as claimed.

Applicant respectfully submits that because it has elected to cancel all claims (i.e., claims 158-163) directed to manufacturing engineered tissue, this rejection no longer applies. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph are respectfully requested.

**V. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Prior claims 157-161 stood rejected under 35 U.S.C. § 112, second paragraph as

indefinite. Specifically, the Examiner asserted that "[c]laims 157-161 are confusing in depending upon cancelled claims 1-4, respectively." Applicant respectfully submits that because it has elected to cancel these claims, this rejection no longer applies. Accordingly, Applicant respectfully submits that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph.

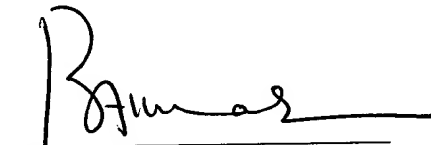
**VI. Conclusion**

Applicant believes that this amendment places the application in condition for immediate allowance. Reconsideration and the early issuance of a Notice of Allowance are earnestly requested.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

Date: September 8, 2003



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